PATENT APPLICATION
Docket No. 2705-187

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Peter Michael Gits, et al.

Conf. No.   9267

Serial No.   09/882,221   Examiner: Thomas Duong

Filed: June 15, 2001   Group Art Unit: 2145

For: NET LURKERS

Date: May 15, 2006

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

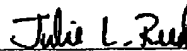This request is being filed with a Notice of Appeal.

This review is requested for the reason(s) stated on the attached sheet(s). Note: no more than five (5) pages may be provided.

I am the:
- ☐   applicant/inventor
- ☐   assignee of record of the entire interest
       See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed)
- ☒   attorney or agent of record
- ☐   attorney or agent acting under 37 CFR 1.34

Total of 4 forms are submitted.

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Respectfully submitted,
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ARGUMENTS IN SUPPORT OF PRE-APPEAL BRIEF CONFERENCE

The main reference, Saulpaugh, teaches away from the use of JavaSpaces and Jini, which are required by the Applicants' claims.

A *prima facie* case of obviousness may be rebutted by showing that the art, in any material respect, teaches away from the claimed invention. *In re Geisler*, 116 F.3d 1465, 1471, 43 USPQ2d 1362, 1366 (Fed. Cir. 1997).

Saulpaugh makes it clear that the "distributed computing environment" disclosed in Saulpaugh is distinguishable from the Space of the claims. Saulpaugh includes several columns listing the limitations of Jini technology and JavaSpaces. A few examples are provided below.

"[F]or certain types of devices, Jini may not be appropriate" (column 3, lines 30-31).

"Current distributed computing technologies, such as Jini, may not be scalable enough for the needs of all types of clients" (column 3, lines 52-54).

"Existing connection technologies, such as Jini, may not be as scalable as desired because they are too big" (column 4, lines 4-5).

"Serization [*sic*] is too large, requiring a large amount of code. Also, serialization is a Java specific object interchange format and thus may not be used with non-Java devices" (column 5, lines 35-37).

"[T]he Jini technology uses JavaSpaces as persistent object containers. However, a JavaSpace can only store Java objects and cannot be implemented in small devices. Each object in a JavaSpace is serialized and pays the above-described penalties associated with Java serialization" (column 6, lines 28-32).

"Jini leases are time based which may result in a number of problems" (column 6, lines 44-45).

"As discussed above, current technology, such as Jini, may not be practical . . . . it may be desirable to locate services based on the physical location of the user and his mobile client" (column 7, lines 16-21).

As should be clear from the example quotations (all taken from the background section of Saulpaugh), the system disclosed in Saulpaugh is designed to provide a functionality that Jini and JavaSpaces could not provide. The invention as claimed is based directly on the functionality that Saulpaugh decries: the use of a permanent store, such as JavaSpaces. This is supported in the specification at page 4, lines 3-11.

Further, Saulpaugh professes the usefulness of being able to locate a user and his mobile client in the disclosure would suggest that Jini and JavaSpaces do not and cannot provide this functionality. As this application shows, this functionality is possible with Jini and JavaSpaces. Therefore, Saulpaugh is teaching away from the invention, and the claimed invention achieves results that would be unexpected relative to the prior art. See In re Geisler, 116 F.3d 1465, 1469-71, 43 U.S.P.Q.2d 1362, 1366 (Fed. Cir. 1997).

Because Saulpaugh teaches away from JavaSpaces, there is no motivation to combine Saulpaugh with Theimer.

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also *In re Lee*, 277 F.3d 1338, 1342-44, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002).

A person skilled in the art, attempting to implement the invention, would not attempt to combine Saulpaugh and Theimer. As discussed above, Saulpaugh makes it clear that he considers JavaSpaces a technology inadequate to the task. Thus, someone reading Saulpaugh

would conclude that JavaSpaces could not be used to implement a network lurking agent, or a system to support such a network lurking agent, and would make no such attempt. This also means that such a person would not be motivated to combine Saulpaugh with Theimer. Thus, the Examiner is incorrect in his assertion that there is a motivation to combine Saulpaugh and Theimer.

If the combination of Saulpaugh and Theimer were valid, the combination would not teach the claimed invention.

As argued above, a person skilled in the art would not be motivated to combine Saulpaugh and Theimer. For clarification, consider the possibility that a person of ordinary skill in the art were to attempt to combine the references anyway. The Applicant is not acknowledging in any way that there is any motivation to make this combination.

Because Saulpaugh describes in great detail the weaknesses of JavaSpaces and Jini, one skilled in the art would not use JavaSpaces as the space described in Saulpaugh. Instead, one skilled in the art would use the variety of space advocated by Saulpaugh, which would not be JavaSpaces. As stated by Saulpaugh at column 6, lines 29-30, "a JavaSpace can only store Java objects and cannot be implemented in small devices". Since Saulpaugh describes it as important to provide "a heterogeneous object repository for distributed computing that may scale from small to large devices" (column 6, lines 33-35), a person skilled in the art would conclude that JavaSpaces is not the appropriate model for a persistent store, and would not use a JavaSpace as a persistent store. This would result in a system implemented by one skilled in the art that would not be the claimed invention. Thus, the theoretical combination of Saulpaugh and Theimer would not be the claimed invention.

The Examiner is employing an improper use of hindsight.

In responding to the Applicant's arguments, the Examiner argued that technological advances have made storage in small devices available. **At the time that Saulpaugh filed his patent application, small devices did not offer sufficient storage to support Java.** This is made clear by the Examiner's citation to Saulpaugh, column 4. However, in that section, Saulpaugh was, again, indicating why Jini was incapable of providing the functionality he needed, showing again that Saulpaugh teaches away from Jini and/or JavaSpaces.

Further, the Examiner made bald statements that devices today provide sufficient storage. Aside from the fact that the Examiner's statement is unsubstantiated, that devices today might provide sufficient storage does not support an obviousness rejection. In arguing

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that devices today are capable of providing the storage needed, the Examiner is arguing from hindsight, which is impermissible.

It is long established that "[a]ny judgment on obviousness is in a sense necessarily a reconstruction based on hindsight reasoning, but *so long as it takes into account only knowledge which was within the level of ordinary skill in the art at the time the claimed invention was made* and does not include knowledge gleaned only from applicant's disclosure, such a reconstruction is proper." *In re McLaughlin* 443 F.2d 1392, 1395, 170 USPQ 209, 212 (CCPA 1971).

Since Saulpaugh makes it clear that devices at the time did not provide sufficient space to suit his needs, to argue that advances in technology made small devices with sufficient storage possible is arguing from hindsight. This is impermissible.

In addition, the Examiner has completely overlooked a central word in his citation to Saulpaugh: that the devices require a certain amount of "processing". In other words, storage space alone is not enough for small devices to provide the functionality Saulpaugh describes. The Examiner has not made any comment about whether it was obvious that devices would have sufficient processing capability.

The Examiner cites to sections of Saulpaugh that are off point

In citing to columns 8, 11, 12, and 16 of Saulpaugh, the Examiner points to a number of different topics: a gate factory, a message capable network layer, and APIs. The Applicant fails to understand the Examiner's reasoning in citing these sections. None of these citations have anything to do with how the "space facility" might be constructed. Instead, these citations discuss other aspects of Saulpaugh. Because the citations have nothing to do with the construction of the "space facility" of Saulpaugh, these sections are without any merit.

In particular, the Examiner cites to the end of column 15 and the start of column 16, where Saulpaugh describes the distributed computing environment protocol definition. The Applicant thinks it worth noting that Saulpaugh states that the definition does not require, imply, or preclude the possibility of Java on the device. The Applicant argues that this shows that Saulpaugh's "space facility", whatever it is, is not implemented in Java. If the device discussed in columns 15-16 of Saulpaugh can operate without implementing Java, then the "space facility" is not implemented using Jini and/or JavaSpaces. And if the device under consideration can support Java or not, then that choice is for whatever other purpose the device might want to support Java: it has nothing to do with the implementation of the "space facility".

The Applicant also asserts all arguments made previously, whether or not explicitly discussed herein, to preserve the right to assert these arguments in the Appeal Brief.

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> I hereby certify that this correspondence is being transmitted to the U.S. Patent and Trademark Office via facsimile number (571) 273-8300 on May 15, 2006.
>
> Signature _Janet Sullivan_
> Janet Sullivan

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